



UNITED STATES PATENT AND TRADEMARK OFFICE

m-l

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,427	03/30/2004	Kimberley Friedman	5067.001	3367

27324 7590 11/02/2006

MARK D. BOWEN, ESQ.
Sterns, Weaver, Miller, Weissler, Alhadeff & Sitte
NEW RIVER CENTER
200 EAST LAS OLAS BLVD, SUITE 2100
FT. LAUDERDALE, FL 33301

EXAMINER

SAMS, MATTHEW C

ART UNIT	PAPER NUMBER
----------	--------------

2617

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/812,427	Applicant(s) FRIEDMAN ET AL.	
	Examiner Matthew C. Sams	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on 8/10/2006.
2. Claim 5 has been canceled and claims 7 & 8 have been added.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnunen et al. (US-6,813,501 hereafter, Kinnunen) in view of Portman et al. (US-6,944,447 hereafter, Portman).

Regarding claim 1, Kinnunen teaches a method of distributing location-relevant advertising information over a wireless communications network to a system user comprising obtaining advertising information from advertisers (Col. 14 lines 38-48), the

Art Unit: 2617

advertising information including advertising content and GPS coordinates (Col. 12 lines 8-30 and Col. 14 lines 38-48), storing the advertising information in a database (Fig. 2 [260] and Col. 12 lines 8-30), transmitting on the wireless communication network, advertising information to a receiver for display on an electronic display (Col. 11 lines 54-67), continually obtaining GPS coordinates of at least one receiver (Col. 10 line 8 through Col. 11 line 30), comparing the receiver GPS coordinates with GPS coordinates contained in advertising information (Col. 13 lines 14-21) and displaying an interactive map with information to guide a user to reach a particular location (analogous to a moving map display depicting a location), but differs from the claimed invention by not explicitly reciting determining proximity between the receiver GPS coordinates and the advertising GPS coordinates and displaying the advertising content on the display based on proximity.

In an analogous art, Portman teaches a method and system for location-based services that includes determining the proximity between the receiver GPS coordinates and the advertising GPS coordinates and displaying the advertising content on the display based on proximity. (Col. 6 lines 13-34 and Col. 17 line 38 through Col. 18 line 43) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the location dependent information system of Kinnunen after modifying it to incorporate the proximity determining and listing of Portman. One of ordinary skill in the art would have been motivated to do this since it allows the user to minimize traveling distance when trying to find a specific service. (Col. 18 lines 53-67)

Regarding claim 2, Kinnunen in view of Portman teaches providing input to the receiver in the form of keywords (Portman Col. 18 lines 21-43), comparing the keywords

Art Unit: 2617

associated with the advertising information (Portman Col. 11 lines 25-37 and Col. 18 lines 21-43) and displaying the advertising content for advertising information on the display based on the input. (Portman Col. 17 line 5 through Col. 18 line 67)

Regarding claim 3, Kinnunen in view of Portman obvious teaches the wireless communication network includes communication satellites when using GPS. (Kinnunen Col. 1 lines 44-54 and Portman Col. 6 lines 13-34)

Regarding claim 4, Kinnunen teaches a method of distributing location-relevant advertising information over a wireless communications network to a system user comprising obtaining advertising information from advertisers (Col. 14 lines 38-48), the advertising information including advertising content and GPS coordinates (Col. 12 lines 8-30 and Col. 14 lines 38-48), storing the advertising information in a database (Fig. 2 [260] and Col. 12 lines 8-30), charging advertisers a recurring fee for storing and transmitting the advertising information (Col. 16 lines 22-26), transmitting on the wireless communication network, advertising information to a receiver for display on an electronic display (Col. 11 lines 54-67), continually obtaining GPS coordinates of at least one receiver (Col. 10 line 8 through Col. 11 line 30), comparing the receiver GPS coordinates with GPS coordinates contained in advertising information (Col. 13 lines 14-21) and charging a receiver user a subscription fee for receiving advertising information. (Col. 10 lines 4-7) Kinnunen differs from the claimed invention by not explicitly reciting determining proximity between the receiver GPS coordinates and the advertising GPS coordinates and displaying the advertising content on the display based on proximity.

In an analogous art, Portman teaches a method and system for location-based services that includes determining the proximity between the receiver GPS coordinates

Art Unit: 2617

and the advertising GPS coordinates and displaying the advertising content on the display based on proximity (Col. 6 lines 13-34 and Col. 17 line 38 through Col. 18 line 43), providing input to the receiver in the form of keywords (Col. 18 lines 21-43), comparing the keywords associated with the advertising information (Col. 11 lines 25-37 and Col. 18 lines 21-43) and displaying the advertising content for advertising information on the display based on the input. (Col. 17 line 5 through Col. 18 line 67) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the location dependent information system of Kinnunen after modifying it to incorporate the proximity determining, listing and searching of listings of Portman. One of ordinary skill in the art would have been motivated to do this since it allows the user to minimize traveling distance when trying to find a specific service. (Col. 18 lines 53-67)

Regarding claim 7, Kinnunen in view of Portman teaches a step of displaying discounted prices from a shop to a mobile terminal user (Kinnunen Col. 1 line 55 through Col. 2 lines 6) which is analogous to displaying coupons offered by advertisers.

Regarding claim 8, the limitations of claim 8 are rejected as being the same reason set forth above in claim 7.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnunen in view of Portman as applied to claim 4 above, and further in view of Gottfurcht et al. (US-6,611,881 hereafter, Gottfurcht).

Regarding claim 6, Kinnunen in view of Portman teaches the limitations of claim 4 above, but differs from the claimed invention by not explicitly reciting the advertising content is displayed in a prioritized order based on the fees paid by the advertisers.

In an analogous art, Gottfurcht teaches displaying the advertising content in a prioritized order based on the fees paid by the advertisers. (Col. 1 lines 26-41) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the location dependent information system of Kinnunen in view of Portman after modifying it to incorporate the fee based prioritizing of Gottfurcht. One of ordinary skill in the art would have been motivated to do this since fee based prioritized listings is a common way for a communication network to generate revenue from the content providers using the network.

Response to Arguments

7. Applicant's arguments filed 8/10/2006 have been fully considered but they are not persuasive.
8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a moving map display that **provides the user with directions** to the advertiser's location, Page 7 Para 1) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. In response to applicant's argument that "It is axiomatic that in order to justify combination of references it is not only necessary that it be physically possible to combine them, but that the art contain something to suggest the desirability of doing so" (Page 7 Para 2), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kinnunen and Portman are directed to analogous subjects (location dependent or based services). Kinnunen teaches a method of distributing location-relevant advertising information over a wireless communications network to a system

Art Unit: 2617

user comprising obtaining advertising information from advertisers (Col. 14 lines 38-48), the advertising information including advertising content and GPS coordinates (Col. 12 lines 8-30 and Col. 14 lines 38-48), storing the advertising information in a database (Fig. 2 [260] and Col. 12 lines 8-30), transmitting on the wireless communication network, advertising information to a receiver for display on an electronic display (Col. 11 lines 54-67), continually obtaining GPS coordinates of at least one receiver (Col. 10 line 8 through Col. 11 line 30), comparing the receiver GPS coordinates with GPS coordinates contained in advertising information (Col. 13 lines 14-21) and displaying an interactive map with information to guide a user to reach a particular location (analogous to a moving map display depicting a location), but differs from the claimed invention by not explicitly reciting determining proximity between the receiver GPS coordinates and the advertising GPS coordinates and displaying the advertising content on the display based on proximity.

Portman teaches a method and system for location-based services that includes determining the proximity between the receiver GPS coordinates and the advertising GPS coordinates and displaying the advertising content on the display based on proximity (Col. 6 lines 13-34 and Col. 17 line 38 through Col. 18 line 43), providing input to the receiver in the form of keywords (Col. 18 lines 21-43), comparing the keywords associated with the advertising information (Col. 11 lines 25-37 and Col. 18 lines 21-43) and displaying the advertising content for advertising information on the display based on the input. (Col. 17 line 5 through Col. 18 line 67) At the time the invention was made, it would have been obvious to one of ordinary skill in the art implement the location dependent information system of Kinnunen after modifying it to incorporate the

Art Unit: 2617

proximity determining, listing and searching of local services of Portman. One of ordinary skill in the art would have been motivated to do this since it provides a more robust location based service that saves the user time and money by allowing the user to receive location dependent advertisements (Portman Col. 10 lines 27-48), search locally proximate services (Portman Col. 18 lines 22-43) and then minimize the traveling distance when trying to find a specific service. (Portman Col. 18 lines 53-67)

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

Art Unit: 2617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCS
10/19/2006


LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER